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37945 DUKE W. YEE YEE AND ASSOCIATES, P.C. P.O. BOX 802333 DALLAS, TX 75380	7590 01/11/2010		<div>EXAMINER</div> <div>MUHEBBULLAH, SAJEDA</div>	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD C. FERRI, MOON JU KIM, JONATHAN MARK
WAGNER, and WILLIAM GEORGE WHITE

Appeal 2009-006546
Application 10/730,957¹
Technology Center 2100

Decided: January 7, 2010

Before LANCE LEONARD BARRY, JEAN R. HOMERE, and JAY P.
LUCAS, *Administrative Patent Judges*.

LUCAS, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application filed December 9, 2003. The real party in interest is International Business Machines Corporation.

STATEMENT OF THE CASE

Appellants appeal from a final rejection of claims 1-48 under authority of 35 U.S.C. § 134(a). The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

Appellants' invention relates to a method for organizing a computer user's desktop icons (claim 1). In the words of Appellants:

The ... invention ... is a method of organizing icons on a desktop into groups and displaying the icon groups in segments on the desktop. . . . The user defines the segment location, the segment size, the types of icons associated with the segment, the icon organization within the segment, and whether the segment covers the desktop wallpaper. The [Icon Grouping Program] analyzes the icons and places the icons into the proper segments based on the type of application associated with the icon. The [Icon Organization Program] organizes the icons within each segment The [program] also organizes new icons that are added to the desktop.

(Spec. ¶ [0010]).

Claim 1 is exemplary:

1. A method for automatically organizing a plurality of icons on a computer desktop, comprising:

using a computer, performing the following series of steps:

displaying a graphical user interface having a define segments menu and a submit control;

responsive to a user selecting a segment location, a segment size, an icon group, a icon organization at the define segments menu, and activating the submit control,

creating a segment on the desktop;

defining the segment size in relation to the desktop;

classifying the plurality of icons into the icon group;

placing the icon group into the segment; and

organizing the icons within the segment in accordance with the icon organization;

wherein the only user actions required to automatically organize the plurality of icons on the computer desktop are for a user to make a plurality of user selections at the define segments menu and to activate the submit control.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Bolnick	US 6,043,817	Mar. 28, 2000
Scott	US 6,545,687 B2	Apr. 08, 2003
Nason	US 6,717,596 B1	Apr. 06, 2004

(filed Nov. 28, 2000)

REJECTIONS

The Examiner rejects the claims as follows:

R1: Claims 1-4, 10-13, 16, 17, 21-28, 34-37, 40, 41, and 45-48 stand rejected under 35 U.S.C. § 102(b) for being anticipated by Bolnick.

R2: Claims 5-7, 18-20, 29-31, and 42-44 stand rejected under 35 U.S.C. § 103(a) for being obvious over Bolnick in view of Scott.

R3: Claims 8, 9, 14, 15, 32, 33, 38, and 39 stand rejected under 35 U.S.C. § 103(a) for being obvious over Bolnick in view of Nason.

Claim 1 is representative. *See* 37 C.F.R. § 41.37 (c) (vii). *See also In re McDaniel*, 293 F.3d 1379, 1383 (Fed. Cir. 2002) (“If the brief fails to meet either requirement [of 37 C.F.R. § 1.192(c)(7)], the Board is free to select a single claim from each group of claims subject to a common ground of rejection as representative of all claims in that group and to decide the appeal of that rejection based solely on the selected representative claim.”).

Appellants contend that the claimed subject matter is not anticipated by Bolnick, or rendered obvious by Bolnick in combination with Scott or Nason because Bolnick fails to teach the step of “organizing the icons within the segment,” as recited in exemplary claim 1, and the claim limitation “wherein the only user actions required to automatically organize the plurality of icons” (claim 1). (*See* App. Br. 8, bottom and App. Br. 9, top.) The Examiner contends that each of the claims is properly rejected (Ans. 12, top).

Rather than repeat the arguments of Appellants or the Examiner, we refer to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this

opinion. Arguments that Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived.

We affirm the rejections.

ISSUE

The pivotal issue before us is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. §§ 102(b) and 103(a). Specifically, the issue turns on whether Appellants' claimed "segment" (claim 1) reads on Bolnick's frame and whether Bolnick teaches "automatically organizing a plurality of icons," as recited in claim 1.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

Disclosure

1. Appellants have invented a method of organizing icons on a computer desktop (claim 1). Icons are organized into a segment placed in one of several areas (*e.g.*, bottom, left, right, or center) on the computer desktop (Spec. ¶ [0032]). Segment size can be adjusted to set the width and height (*id.*). Within segments, the method sorts and arranges icons. (*See* claim 1.)

Bolnick

2. The Bolnick reference teaches a method of organizing icons on a computer desktop (col. 7, ll. 31-33). Icons are organized in a frame placed in one of several areas (*e.g.*, bottom, left, right, or center) on

Bolnick's computer desktop. (*See* col. 18, ll. 47-49; Fig. 22B.) Frame size can be adjusted by a Layout Editor menu to set a specific width and height. (*See* col. 19, ll. 30-33 and 40-44.) Within frames, Bolnick's Global Cleanup Operation sorts and arranges icons (col. 21, ll. 40-43 and 47-49). Bolnick also teaches adding icons and adjusting the frame space allotted to the icons accordingly. (*See* col. 31, ll. 40-50.)

Scott

3. The Scott reference discloses a method of changing the size of icons to fill a display window, (*i.e.*, the "segment," as claimed). (*See* col. 16, ll. 17-22; Ans. 10, middle.)

Nason

4. The Nason reference discloses a desktop with default wallpaper (Fig. 33, element 3301; col. 26, ll. 26-29; Ans. 10, bottom). Anything displayed within a computer screen is an onscreen work area, or Nason's desktop. (*See id.*) Nason further discloses display segments (*id.* at elements 3302-3305) that do not cover the wallpaper (*id.* at element 3301).

PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

In rejecting claims under 35 U.S.C. § 102, "[a] single prior art reference that discloses, either expressly or inherently, each limitation of a

claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citation omitted).

ANALYSIS

From our review of the administrative record, we find that the Examiner has presented the rejections of Appellants’ claims under 35 U.S.C. §§ 102(b) and 103(a) on pages 3 to 8 of the Examiner’s Answer. In opposition, Appellants present a number of arguments.

*Arguments with respect to the rejection
of claims 1 to 4, 10 to 13, 16, 17, 21 to 28, 34 to 37, 40, 41, and 45 to 48
under 35 U.S.C. § 102(b) [R1]*

We address Appellants’ argument that Bolnick’s frame is not the same as the claimed “segment” (App. Br. 8, bottom).

More specifically, Appellants argue:

The cited portion of Bolnick, by contrast, does not discuss organizing icons within a desktop segment by resizing the icons within the segment. Bolnick’s sorting of icons does not meet claim 1’s requirement of ‘organizing the icons’ because Bolnick only orders the icons within a frame and does not resize the icons within a desktop segment.

(*Id.*)(emphasis omitted).

In reply, the Examiner points out in the Answer that resizing the icons, as argued above, is not recited in claim 1. (Cite???)

Claim 1 merely recites, in relevant part, “organizing the icons within the segment in accordance with the icon organization.” Appellants’ claim language fails to specify how the icons are organized (*e.g.*, that the icons are “resized,” as Appellants have argued above). We thus agree with the Examiner’s finding that Appellants’ argument is not commensurate with the

scope of claim 1. Accordingly, we find no error. We can only credit those limitations that are recited in the claims. Further, we note that Bolnick's Global Cleanup Operation, which sorts and arranges frames (FF#2), is sufficient to meet the broad claim limitation "organizing the icons," as argued above by Appellants.

Next, Appellants contend that Bolnick fails to teach the claim limitation "automatically organize the plurality of icons." (claim 1) (Brief 9, top.).

More specifically, Appellants contend:

[E]mbodiments according to claim 1 require far fewer user actions to cause an automatic organization of icons on the computer desktop. The simplified process is enabled by the define segments menu which provides selections to the user. Unlike Bolnick, in embodiments according to claim 1 the user is not required to define fields or enter data.

(*Id.*).

The Examiner points out in the Answer that Bolnick teaches a Layout Editor menu that generates a "frame" (cited as teaching Appellants' claimed "segment") with modifiable fields, such as name, filter properties, sorting properties, fill properties, position, size, and automatic behavior. (*See* col. 18, ll. 45-51; Ans. 3, bottom.)

We agree with the Examiner's findings, in that Appellants' "define segments menu" reads on Bolnick's Layout Editor menu (*id.*). We find that Appellant's invention organizes icons into a segment, which may be placed in one of several areas (*e.g.*, bottom, left, right, or center) on the computer desktop (FF#1). In Appellants' invention, segment size can be adjusted to set the width and height (*id.*). In comparison, Bolnick's icons are organized

in a frame (Appellants' claimed "segment"), which may be placed in one of several areas (*e.g.*, top, bottom, left, right, or center) on the computer desktop (the same as Appellants' claimed desktop) (FF#2). In Bolnick, the frame size can be adjusted by a Layout Editor menu to set the width and height (*id.*). Based on the findings (FF#1, FF#2) above, we find unconvincing Appellants' arguments that Bolnick's Layout Editor menu does not teach the claimed "define segments menu." Accordingly, we find no error in the Examiner's analysis of claim 1.

Claim 4 recites, in part, "wherein the organization of the icons is to shrink the icons down to the icons' smallest possible size."

Regarding claim 4, Appellants argue: "Bolnick does not discuss resizing icons to smallest size possible, but rather discusses the fact that the Windows GUI allows icons to be resized. This is not an organization scheme whereby icons within a segment are given a minimum size so that the number of icons within a segment is maximized." (App. Br. 9, bottom.)

In reply, the Examiner points out that Bolnick teaches selecting a new icon size within a frame (Appellants' claimed "segment") at column 31, lines 40 to 50. In the cited passage, the patent says that when new icons are added, Bolnick's system recalculates the column numbers within a frame, such that "the original smallest horizontal margin for each frame" is maintained (*id.*).

We are not convinced by Appellants' argument that the claim requires maximizing the number of icons within a segment (App. Br. 9, bottom) because the argument is not commensurate with the scope of claim 4. To "shrink the icons down to the icons' smallest possible size," as recited in claim 4, is not the same as minimizing the size of icons within a segment "so

that the number of icons within a segment is maximized,” as argued by Appellants (*id.*). Notwithstanding the fact that Appellants’ argument differs in scope from the claim limitation, the Examiner finds in Bolnick a teaching that meets both the claim and Appellants’ interpretation of the claim language. We find that Bolnick teaches adding icons and adjusting the frame space allotted to the icons accordingly (FF#2). Thus, in Bolnick, adding (n+1) icons results in a proportionate reduction in icon size. (*See id.*) This teaching suffices to meet the claim limitation “wherein the organization of the icons is to shrink the icons down to the icons’ smallest possible size,” as claimed. We note that the Specification discloses that the icon source code dictates the “smallest possible size” and entails reducing the space between icons until all of the icons fit into the segment (§ [0038]). In view of the Specification (*id.*), the findings of fact (FF#2), and the analysis above, we see no difference between the “smallest possible size,” as claimed, and Bolnick’s teachings. Accordingly, we decline to find error in the examination of claim 4.

We selected claim 1 as representative of the grouping for rejection [R1]. Accordingly, claims 2, 3, 10-13, 16, 17, 21-28, 34-37, 40, 41, and 45-48 fall with representative claim 1.

*Arguments with respect to the rejections
of claims 5 to 9, 14, 15, 18 to 20, 29 to 33, and 38, 39, 42 to 44
under 35 U.S.C. § 103(a) [R2 and R3]*

Appellants separately argued each of claims 5-9. (*See App. Br. 10, middle to App. Br. 14, top.*) We thoroughly reviewed the opening Brief and the Reply Brief, the Answer, and the cited references. We find that the

Examiner has adequately responded to each of Appellants' contentions, and we adopt his findings and analysis (Ans. 5, bottom to Ans. 8, top.) We refer Appellants to the "Response to Arguments" section of the Examiner's Answer for further details. (See Ans. 9, middle to Ans. 10, bottom.) Accordingly, we find no error in the Examiner's analysis of claims 5-9.

No arguments were made concerning the remaining claims 14, 15, 18-20, 29-33, and 38, 39, 42-44. Accordingly, we find no error regarding the Examiner's analysis of these claims.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 1-48.

DECISION

We affirm the Examiner's rejections [R1 to R3] of claims 1-48.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

peb

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